

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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L. Woerner, Inc.  
v.  
Healthcare Retirement Corporation of America,  
a.k.a. Healthcare and Retirement Corporation

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Cancellation No. 92028027

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Erika N.D. Stanat of Harter, Secrest & Emery LLP for L.  
Woerner, Inc.

Gene A. Tabachnick of Reed Smith LLP for Healthcare  
Retirement Corporation of America, a.k.a. Healthcare and  
Retirement Corporation.

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Before Hairston, Bucher, and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 11, 1998, L. Woerner, Inc. (petitioner)  
filed a petition to cancel Registration No. 1,793,002  
owned by respondent, Healthcare Retirement Corporation of  
America, a.k.a. Healthcare and Retirement Corporation for  
the mark HCR (stylized) shown below:



The registration<sup>1</sup> is for "educational services; namely, conducting classes, seminars, and workshops for health care training" in International Class 41 and "health care; physical and occupational rehabilitation; transitional health care; nursing home care" in International Class 42.

Petitioner seeks to cancel respondent's registration on the ground that there is a likelihood of confusion with its common law mark HCR that it alleges it has continuously used with health care services. Respondent denied the salient allegations of the petition to cancel.

#### The Record

The record consists of the file of the involved registration; the trial testimony deposition, with accompanying exhibits, of petitioner's founder, Louise Woerner; the trial testimony deposition, with accompanying exhibits, of R. Jeffrey Bixler, respondent's

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<sup>1</sup> The registration issued September 14, 1993, and it is based on an application filed October 9, 1992. The registration contains an allegation of a date of first use and a date of first use in commerce of December 3, 1984.

general counsel and secretary; and respondent's three notices of reliance.<sup>2</sup> Both parties have filed briefs. An oral hearing was held on June 17, 2003.

### Facts

As discussed below, the critical period in this proceeding concerns the use of the term HCR by the parties in 1981. On February 19, 1981, the Board of Directors of respondent, which was originally known as Wolfe Industries, Inc., voted to change the name of the corporation to "Health Care and Retirement Corporation of America ('HCR')" subject to the approval of shareholders. Bixler dep. at 9-10 and Ex. 5 at 3. Respondent alleges that it has continuously provided health care services since the inception of HCR in 1981. Bixler dep. at 14.

In 1978, petitioner's predecessor, HomeCall of Rochester, Inc., was incorporated "to perform the following functions: yard work, shopping, transportation, meal planning and preparation, companionship, housecleaning, laundry, and any other similar non-medical services. The corporation will not practice the profession of nursing." Woerner dep., Ex. 1. However, by November 12, 1981, HomeCall of Rochester, Inc. changed its name to L. Woerner, Inc. and the

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<sup>2</sup> There are numerous evidentiary objections to the evidence that

certificate of incorporation indicated that the corporation would "not practice the profession of nursing but will provide licensed nurses to care for clients in their home." Woerner dep., Ex. 3. On April 12, 1982, a paper entitled "Written Consent of the Sole Director of L. Woerner, Inc." approved "the use by the Corporation of the assumed name 'HCR' in the conduct of its business activities." Woerner dep., Exhibit 5. Petitioner's financial report indicates that in 1981, petitioner received \$163,379 in revenues from "personal care services." Woerner dep., Exhibit 12.

Both petitioner and respondent now use the mark HCR on various health care related services. See Woerner dep. Exhibit 55 (August 1984 advertisement for HCR's personal care, home health, and skilled nursing services) and Exhibit 48 (1997 booklet listing fees for licensed practical nurses and registered nurses); Bixler dep. at 16.

#### Evidentiary Questions

Petitioner has made numerous evidentiary objections to respondent's evidence. Petitioner objects to respondent's submission of a non-status and title copy of its expired registration with a notice of reliance.

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will be discussed subsequently.

Exhibit B. We agree that respondent has not followed the proper procedure for introducing a copy of an expired registration it owned by notice of reliance so we will not consider this evidence. TBMP § 704.03(b)(1) (2d ed. June 2003). However, petitioner's objection to documents (Exhibit I) from respondent's expired registration is overruled inasmuch as respondent has properly introduced the documents by notice of reliance. Id. ("If a party owns a registration which is not the subject of the proceeding and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, it may do so by 1) filing, during its testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e)..."). Petitioner has also objected to respondent's submission of a declaration with an attached franchise agreement by notice of reliance. A declaration or affidavit in lieu of a deposition can be submitted in an inter partes proceeding if the parties stipulate to its admissibility. TBMP § 705 (Parties may stipulate that the "testimony of a witness may be submitted in the form of an affidavit by the witness"). However, there is no stipulation in this case and,

therefore, the declaration and franchise agreement may not be properly submitted by a notice of reliance. 37 CFR § 2.122(e); TBMP 704.02. Therefore, we will not consider Exhibit H.

We overrule petitioner's objection to the exhibits 1 and 3 through 11 in the deposition of Mr. Bixler on the ground that respondent did not lay a proper foundation.<sup>3</sup> Bixler's testimony indicates that he was a corporate officer with responsibility for maintaining all the corporation's books and records (Bixler dep. at 4-5), and respondent laid a proper foundation for these records. Petitioner's objection to Bixler Exhibit 1, a TESS printout of respondent's registration, is overruled. This exhibit is simply a printout of the registration that petitioner seeks to cancel. The information in this registration is already of record in the proceeding automatically. 37 CFR § 2.122(b) ("The file of each application or registration specified in ... each registration against which a petition or counterclaim for

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<sup>3</sup> Exhibits 9, 10, and 11 include three corporate annual reports. Respondent's counsel inquired of the witness if the witness was aware of any inaccurate statements in these annual reports. Bixler dep. at 24, 25, and 26. While the witness answered that he was not aware of any inaccuracies, the witness did not adopt the statements in the annual reports as his testimony. Therefore, the document cannot be used to prove the truth of the matter asserted in it. Accord Berring v. Jacob, 595 S.W.2d 412,

cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose"). Petitioner's objection to respondent's Exhibit 7, another copy of respondent's expired registration, is overruled. Respondent's witness simply referred to the services in the registration to identify the services on which respondent was using the mark. Respondent is not relying on this registration to prove ownership of a Federal registration. TBMP § 704.03(b)(1)(A). We sustain the objection to exhibit 2, which is another copy of the franchise agreement between HomeCall, Inc. and HomeCall of Rochester, Inc. Respondent has not laid a proper foundation for the admissibility of this agreement. Also, we overrule petitioner's objection to respondent's documents on the ground that respondent has not introduced the originals because there is no issue of authenticity or unfairness. See Fed. R. Evid. 1003 (A "duplicate is admissible to the same extent as the original"); Advisory Committee Note ("Therefore, if no genuine issue exists as to authenticity and no other reason exists for requiring the original, a duplicate is admissible under the rule").

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413 (Mo. App. 1980) ("If the statements read are agreed to, they

Finally, we overrule petitioner's objection that respondent did not provide copies to petitioner and a similar objection by respondent that petitioner did not serve a copy of its exhibits on respondent. The evidence to support these objections is inconclusive.

#### Introduction

Petitioner, by alleging use of the same letters on the same or similar services, has standing because it has asserted a claim of likelihood of confusion "which is not wholly without merit." Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982). Also, there is no evidence that petitioner's mark is not inherently distinctive, so we turn to the key issues in the case, priority and likelihood of confusion.

#### Priority

We now examine the evidence to determine who has priority of use of the mark. The difficulty of determining priority is compounded in this case by the length of the time that has elapsed since the allegations of use and the paucity of evidence that was submitted from that period. Respondent's registration issued as a result of an application filed on October 9, 1992. The

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become evidence because the witness adopts them as his own").



registration alleges a date of first use and a date of first use in commerce of December 3, 1984. Respondent now seeks to prove an earlier date of first use. Respondent must prove this earlier date of first use by clear and convincing evidence. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1852 n.7 (Fed. Cir. 1993) ("VCDS alleges use prior to the date that it apparently listed in its registration application as its date of first use, i.e., prior to May of 1985, and therefore VCDS has the burden of establishing that use by clear and convincing evidence instead of mere preponderance of the evidence"); Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) ("Where an applicant seeks to prove a date earlier than the date alleged in its application, a heavier burden has been imposed on the applicant than the common law burden of preponderance of the evidence").

Respondent alleges that "[s]ince May 7, 1981, Registrant HCR has continuously used its HCR mark in connection with the services identified in the registration at issue." Respondent's Brief at 4. As support for this date of first use, respondent refers to the testimony of its witness, a copy of its expired

registration, and its Annual Reports for the years 1981, 1982, and 1983. Respondent's Brief at 18. In addition to the testimony, the following evidence provides some support for respondent's position that it began using the mark in 1981: (1) A March 13, 1981 notice of a special meeting of shareholders on March 27, 1981, to consider a proposal "to create the 'Health Care and Retirement Corporation of America' ('HCR') out of the present Wolfe Companies" (Bixler Exhibit 4); (2) Minutes of a February 19, 1981 Board of Directors meeting that resolved that "subject to the approval of shareholders the Amended Articles of Incorporation of the Corporation are hereby amended to change the name of the Corporation from Wolfe Industries, Inc. to Health Care and Retirement Corporation of America ('HCR')" (Bixler Exhibit 5); a *Lima News* article dated April 20, 1981 that describes the Wolfe Industries reorganization and notes that "HCR will handle design and construction work, financing and leasing services and total management services for the health care and retirement industries" (Bixler Exhibit 8).<sup>4</sup>

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<sup>4</sup> While the newspaper article does not prove the truth of the matter asserted in the article, it does indicate that respondent was known as HCR in 1981.

While the 1981 Annual Report shows the mark HCR on the cover, it obviously was prepared after 1981 because it is a report prepared after the year had concluded. It is dated April 23, 1982. Respondent's later annual reports for 1982 and 1983 are not probative of respondent's use of the mark in 1981. Respondent's newspaper article is dated April 20, 1981, which obviously precedes respondent's asserted date of first use of May 7, 1981. Respondent's Brief at 4. The newspaper article uses the future tense and it does not establish when respondent used the mark in the future. Even the services referred to in the article are not clearly identified ("total management services for the health care and retirement industry").

Respondent has also included a database printout of its expired registration, which is not evidence of the allegations in the document. TBMP § 704.03(b)(1) (An expired registration "is not evidence of anything except that the registration issued").<sup>5</sup> The witness also

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<sup>5</sup> The Federal Circuit has held that "where there is additional evidence relating to actual use, such a [regulatory] license becomes quite probative in that it further corroborates the other evidence. The same applies to a state registration." West Florida Seafood, 31 USPQ2d at 1127. Even if we consider the information about the expired registration to be of record, we note that the mark in that registration HCR HEALTH CARE AND RETIREMENT CORPORATION OF AMERICA and design is significantly different from the mark in this case, HCR (stylized). See Van

testified that respondent was using its mark at that time in a slightly different form with a design and its corporate name (Health Care and Retirement Corporation of America"). See Bixler dep. at 14 and Exhibit 6 (Q. Does HCR use the mark as shown in Exhibit 6 today? A. No). Finally, the witness testified that the corporation was listed on the NASDAQ stock exchange with the symbol, HCRX, "in the early 1980's." Bixler dep. at 27 (The witness also explained that the "X" was used because "NASDAQ required four letters in the stock symbol").<sup>6</sup> This evidence does not establish that respondent began using the mark for the identified services on May 7, 1981.<sup>7</sup>

"[O]ral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a

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Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991) ("'CLOTHES THAT WORK' and 'CLOTHES THAT WORK. FOR THE WORK YOU DO' are not legal equivalents").

<sup>6</sup> Respondent's 1981 Annual Report (p. 24) reports that respondent's stock "has been publicly traded since December 10, 1981 on the over-the-counter market and is quoted on NASDAQ under the symbol HCRX."

<sup>7</sup> Respondent's other evidence consists of a certificate of incorporation for petitioner; petitioner's answers to interrogatories; a copy of a registration for the mark HOMECALL; handwritten notes; pages from a phone directory; and minutes of a meeting from Heartland Health Care Company's Board of Directors meeting in which there is a discussion about forming a new company called Health Care and Retirement Corporation of America.

trademark proceeding." Powermatics, Inc. v. Globe Roofing

Products Co., 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965).

Such testimony should "not be characterized by contradictions, inconsistencies and indefiniteness but should carry with it conviction of its accuracy and applicability." B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945). In this case, respondent's witness apparently did not have personal knowledge of the corporation's use of the mark in 1981.<sup>8</sup> Bixler dep. at 38 (Witness not employed by respondent at the time Exhibit 9, the 1981 Annual Report, prepared). The evidence of respondent's use of the mark in 1981 is nebulous, and its witness's testimony is only somewhat probative. National Blank Book Co. v. Leather Crafted Products, 218 USPQ 827, 828 (TTAB 1983) ("It was incumbent upon opposer in attempting to prove the date of first use of 1968 either to have a witness testify from personal knowledge that the mark 'ESP' was in use as of 1968 or, if no such person was still employed by opposer,

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<sup>8</sup> Apparently, Mr. Bixler joined respondent in 1984. Bixler dep. at 18 ("Since '84, I have personal knowledge of ... these services by HCR").

to prove the date of first use by authenticating business records").

However, we are not unmindful of the Federal Circuit's admonition that we must not view the individual items in the evidence standing alone, but rather as a whole when we are determining priority.

The TTAB concluded that each piece of evidence individually failed to establish prior use. However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece were part of a puzzle which, when fitted together, establishes prior use. The TTAB failed to appreciate this. Instead, the TTAB dissected the evidence to the point it refused to recognize, or at least it overlooked, the clear interrelationships existing between the several pieces of evidence submitted.

West Florida Seafood Inc. v. Jet Restaurants Inc., 31

F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

We do view respondent's Annual Report for 1981 as a form of advertising that shows that the mark HCR in identical or nearly identical stylization was used in association with respondent's nursing home care services by April of 1982. It also corroborates the witness testimony concerning the use of its mark at least by April of 1982. However, we are not convinced by clear and convincing evidence that respondent began using its

mark on the services in the registration on May 7, 1981.<sup>9</sup> Because of the lack of definiteness of the date when use first began, we must assume that respondent did not begin using the mark on its identified services any earlier than the end of April 1982.

Petitioner, on the other hand, does not allege ownership of a registration; rather it relies on its common law rights in the term HCR. In that case, "the decision as to priority is made in accordance with the preponderance of the evidence." Hydro-Dynamics, 1 USPQ2d at 1773. Petitioner's evidence of priority of use is also less than overwhelming, but it shows that petitioner was actually using the term HCR in 1981. Like respondent, petitioner began its business operations under a different name. Petitioner started business operations as HomeCall of Rochester, Inc. in May or June of 1978. Woerner dep. at 11. Petitioner's founder testified that because its original name resulted in people mistakenly assuming that

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<sup>9</sup> While "[p]rior use of a term in advertising, as a tradename, as a style or model designation, or in a purely descriptive sense may be sufficient to prevent a later user from obtaining federal registration of that term, ... [t]his kind of priority, however, is purely defensive." 2 *McCarthy on Trademarks and Unfair Competition* (4<sup>th</sup> ed. 2003), § 16.22. Obviously, we are

the company was an escort service, the employees began to refer to the company as HCR. Woerner dep. at 11-12.

Evidence of the use of the term HCR during the period 1978 to 1981 includes the following. Exhibit 2 is a duck figurine wearing a uniform with the letters HCR on it.

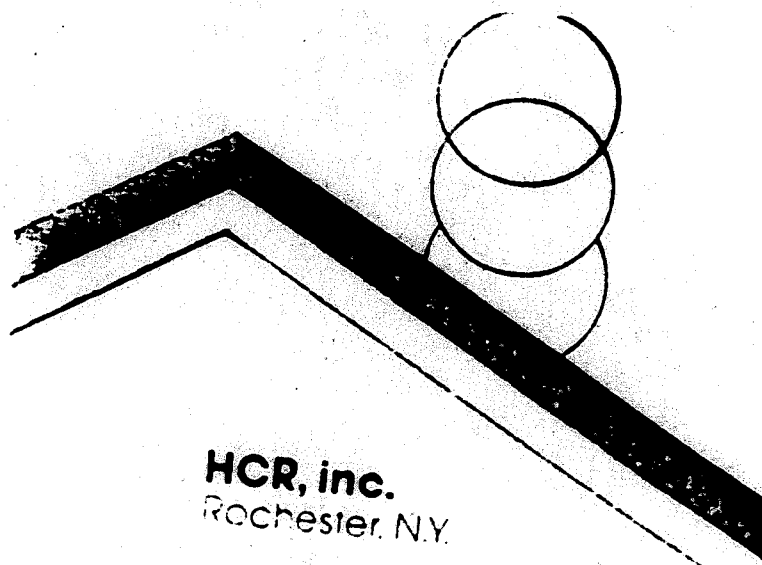
The witness testified that the duck was made by the witness's son as a class project, that the logo on the duck's uniform was first used in 1979, and that petitioner's employees were required to "wear these uniform shirts when they delivered HCR services."

Woerner dep. at 17-18. Petitioner's Exhibit 9 demonstrates that it was using the term HCR, Inc. on letterhead stationery on October 5, 1981. Petitioner also submitted three in-house documents showing use of the term HCR, Inc. Exhibit 73 is entitled "In-Service Training Log" for an employee with entries dating from April 24, 1980, through September 23, 1985. Exhibit 74 is entitled "Employee Check-List" with entries dating from October 25, 1979. Exhibit 75 is entitled "Termination/Reactivation Log" for an employee. It contains one entry under "date of employment" consisting of the notation "January 12, 1980." The letterhead on these exhibits is shown below.

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not called upon to determine in this case whether respondent





Based on these exhibits and the testimony of petitioner's witness, it is clear that petitioner has used the letters HCR at least as part of a trade name even prior to the earliest date (May 5, 1981) alleged by respondent.

While we find that petitioner used the letters HCR first, we now must determine on what services the parties used their respective trade names or trademarks. For respondent, its witness testified that it was using the mark on "health care; physical and occupational rehabilitation; transitional health care; nursing home care" and "educational services; namely, conducting classes, seminars, and workshops for health care training." Bixler dep. at 12-13. Petitioner asserts

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has, or can establish, that it has prior trade name use.

that is has used the trade name HCR "in association with its provision of home health care services and its training and consulting services, including seminars and workshops, since 1978." Petitioner's Brief at 27.

Respondent argues that petitioner "did not deliver health care services until 1988." Respondent's Brief at 13.

Respondent relies on the fact that petitioner's certificate of incorporation identified petitioner's purpose as: "To provide personnel to perform the following functions: yard work, shopping, transportation, meal planning and preparation, companionship, housecleaning, laundry, and other similar non-medical services. The corporation will not practice the profession of medicine or nursing." Respondent's Brief at 13 (emphasis omitted); Petitioner's Exhibit 1. Respondent notes that it was not until 1988 that petitioner's certificate of incorporation was amended to include these health care services.

While petitioner's evidence does not establish that it was providing health care services in 1981 and early 1982, it is clear that petitioner was using HCR as a trade name for services related to assisting patients and the elderly in 1981. Petitioner's "In-Service Training Log" contains the notation "Inservice" in 1980. The

employee newsletters indicate that "inservice" included wrapping Christmas presents and listening to a local congressman speak. Woerner Exhibit 57, p. 2 ("[W]e are holding an inservice here at the office to help wrap gifts which will be put in the Christmas stockings for our clients. This will count in your record as having attended an inservice") and Exhibit 56 ("We are planning our Christmas in-service for December 18, 1981 ... As in the past you are invited to bring a guest ... Our Congressman, Barber Conable, ... plans to speak to us briefly about what home care means to older Americans"). It is not clear what other training was offered in 1981. The exhibits with dates prior to 1982 (Nos. 73-75) appear to be in-house documents. In addition, we have considered petitioner's Exhibits 9 (a letter to petitioner's accountant) and Exhibit 10 (a letter to the Small Business Administration with an attached business plan). Neither exhibit gives any insight into the nature of petitioner's services.<sup>10</sup>

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<sup>10</sup> Petitioner's Exhibit 59 was an unsigned letter with a similar letterhead from petitioner's associate manager to Helen Munier containing minutes from an advisory committee meeting with written notes. Apparently the copy of the letter was obtained from a third party. See Woerner dep. at 146-47.

Petitioner's witness described its services in the summer of 1978 as an "array of home economic services that family members used to do when they were at home to do them" and a "whole variety of things but not medical services, not treatments but care, not cure." Woerner dep. at 12-13. While petitioner had one employee who was a nurse, the witness admitted that petitioner provided "no hands-on care and treatment services." Woerner dep. at 13. Her duties were described as doing "assessments to develop plans of care. She did self-care teaching, she did training for our aides ... We saw ourselves as improving people's functional status, not really an illness care model but helping people to live better than they might otherwise. So she was the technical expert." Woerner dep. at 14.

Based on the evidence, we must conclude that prior to May of 1982, petitioner's home health aide services were likely similar to the functions identified in its certificate of incorporation namely "yard work, shopping, transportation, meal planning and preparation, companionship, housecleaning, laundry, and other similar non-medical services." Petitioner's Exhibit 1. While these services are not nursing home services or transitional health care services, these services were

directed to elderly people and people with health care problems. Petitioner also submitted evidence that in 1981, it amended its certificate of incorporation to provide nursing services. However, it is not clear when petitioner began to provide these nursing or health care services and we cannot conclude that petitioner was providing these services under the HCR trade name or trademark prior to respondent. On the other hand, regarding respondent, we conclude that, at least by the April of 1982, it was providing health care services under the HCR mark. Viewed in its entirety, petitioner's evidence indicates that it was providing non-medical home health aide services to the elderly or people with health problems. Some of these services would undoubtedly be similar to services provided in a nursing home. Therefore, we conclude that petitioner has established priority of use of the term HCR in connection with home health aide and similar non-medical services.

Likelihood of Confusion

We now consider whether the marks as used on the services are confusingly similar in view of the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563,

567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Regarding the marks, we hold that they are for the identical letters HCR. The stylizations in respondent's registered mark and in petitioner's displays of its marks are minimal. Therefore, we conclude that petitioner's and respondent's marks are virtually identical.

The next question concerns the relatedness of the services in connection with which the parties use their respective marks. We have already concluded that petitioner has only submitted evidence that would lead us to conclude that its services in 1981, which are identified as home health aide services, involved doing yard work, shopping, transportation, meal planning and preparation, companionship, housecleaning, laundry, and other similar non-medical services for others.

Respondent's services were educational services; namely,

conducting classes, seminars, and workshops for health care training and health care; physical and occupational rehabilitation; transitional health care; and nursing home care.

While these services are not identical, we conclude that patients receiving health care services or contemplating nursing home care services may also be in need of housecleaning, laundry and other similar non-medical services. When virtually identical marks are used on these services, prospective purchasers are likely to believe that the services originate or are associated with the same source. Therefore, respondent's and petitioner's services are related.

Here, even though petitioner employed a nurse, it did so to improve the delivery of petitioner's home health aide services. Providing health care training, rehabilitation, health care and nursing home care services is significantly different than providing a high school graduate to cook, clean, and shop for an individual. Woerner dep. at 152 (Petitioner's witness refers to its services as "home health aide services"). While we hold that petitioner's home health aide services are related to registrant's health care services, we do

not find that, in early 1982, these services included the same type of services that were provided by respondent.<sup>11</sup>

Laches

Respondent also argues that the petition to cancel should be denied because of laches inasmuch as "petitioner waited ten years to challenge Registrant['s] HCR[] mark." Respondent's Brief at 20. While petitioner may have known

about respondent for ten years, "laches, with respect to protesting the issuance of the registration for the mark, could not possibly start to run prior to when ... [the] application for registration was published for opposition."

National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Inasmuch as respondent's registration was published for opposition on June 22, 1993, and the petition

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<sup>11</sup> We have not considered petitioner's testimony that several phone calls to petitioner were actually intended for respondent or that callers thought that respondent's listing on the New York Stock Exchange with the symbol HCR was a reference to petitioner. These inquiries all appear to have occurred after petitioner and respondent were both using the mark HCR on health care services. There is little doubt that if the parties are using virtually identical marks on the same services, there would be a likelihood of confusion.



for cancellation was filed on September 11, 1998, the applicable period for considering laches is approximately five years.<sup>12</sup>

"To prevail on its affirmative defense [of laches, respondent] was required to establish that there was undue or unreasonable delay by [petitioner] in asserting its rights, and prejudice to [respondent] resulting from the delay." Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001). Petitioner waited approximately five years prior to bringing this petition to cancel. We have held that a five-year period without a significant explanation is an unreasonably long period to wait prior to filing a petition to cancel. Turner v. Hops Grill & Bar Inc., 52 USPQ2d 1310, 1312 (TTAB 1999) ("It is noted that the only reason petitioner presented for his delay is his lack of actual knowledge. Because actual knowledge is not the appropriate measure, and the length of the delay is

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<sup>12</sup> While respondent argues that "Petitioner knew of Registrant's HCR's use and registration of its 'HCR' mark" (Respondent's Brief at 20) that registration was for a different mark, HCR HEALTH CARE AND RETIREMENT CORPORATION OF AMERICA and design, and it was cancelled on June 2, 1989. It is not clear how laches could apply to a party's knowledge of a registration of a

clearly substantial, petitioner's delay in objecting to respondent's registration is unreasonable"). While petitioner indicates that recent incidents of alleged actual

confusion may have prompted the filing of the petition to cancel (Woerner dep. at 179-180), waiting to see if there is actual confusion does justify a long delay in filing a petition to cancel. We note that petitioner does not allege it was without actual knowledge of respondent's mark. Second, respondent has indicated that it spends millions of dollars advertising its services. Bixler dep. at 30. Certainly, by delaying the filing of the petition to cancel, respondent has been prejudiced to the extent that it has expended millions of dollars continuing to promote and develop a mark that petitioner was planning to petition to cancel. See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc., 971 F.2d 732, 23 USPQ2d 1701, 1704 (Fed. Cir. 1992) ("Opposer's right to prevail in this proceeding arises from the particular provisions of the Lanham Act that are designed to encourage registration of marks. Opposer took advantage of those provisions. Applicant did not. Applicant, as prior user, could and should have taken steps to prevent

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different mark that was subsequently cancelled shortly after the

registration by Opposer of the mark LINCOLN. It had an opportunity to oppose or petition to cancel Opposer's registration during a period of more than five years and failed to avail itself of that opportunity").

The last point we discuss is whether the confusion is inevitable because, if it is, then the defense of laches is not applicable. Reflange Inc. v. R-Con International, 17 USPQ2d 1125, 1131 (TTAB 1990) ("It is not necessary to discuss this theory because it is well established that equitable defenses such as laches and estoppel will not be considered and applied where, as here, the marks of the parties are identical and the goods are the same or essentially the same"). Here, we cannot hold that confusion would be inevitable when virtually identical marks would be used on the services of doing yard work, shopping, cleaning, and similar services for others and respondent's health care related services. The evidence does not demonstrate that potential customers would inevitably be confused when they see these marks on nursing home and health care services and the service of providing high school graduates to cook and clean and do yard maintenance for elderly people or people with health problems.

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party became aware of it.

**Cancellation No. 92028027**

Therefore, inasmuch as petitioner has waited almost five years after the issuance of respondent's registration and respondent has continued to spend substantial amounts in promoting its services under the HCR mark, we determine that petitioner has delayed too long in filing this petition to cancel.

Decision: The petition to cancel Registration No. 1,793,002 is denied.